

REMARKS

- I. The rejection of Claims 1-63 under 35 U.S.C. §101 as being directed to non-statutory subject matter is unfounded and should be withdrawn.

Claims 1-63 stand rejected under 35 U.S.C. § 101 on the basis of the allegation that the claimed invention is directed to non-statutory subject matter. Applicants respectfully traverse this rejection. While not conceding that the prior claims are directed to non-statutory subject matter, but instead to expedite prosecution, Applicants have chosen to amend Claims 1, 2, 4-24, and 27-37. Applicants respectfully disagree with the Final Office Action's rejection and reserve the right, for example, in a continuing application, to establish that the previous claims are not directed to non-statutory subject matter.

Regarding independent Claims 1, 19, 36 and 50, the Final Office Action states that:

For a claim to be statutory under 35 U.S.C. § 101 the following condition must be met: ... In the claim, the practical application of an algorithm or idea results in a useful, concrete, tangible result.

According to the above guidelines, Applicant's [*sic*] claims are limited to the manipulation of abstract ideas in the context of patentability because the claim lacks an indication of usefulness.

Final Office Action, p. 2. Applicants interpret the position taken by the Final Office Action to be that of the claims somehow lacking usefulness by virtue of the claims reciting only the manipulation of abstract ideas. Applicants, respectfully, do not agree with any of these propositions.

Applicants respectfully submit that 35 U.S.C. § 101, relevant case law, and the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility of October 26, 2005, require nothing that is not already provided by the claims, as amended (or as originally submitted). As correctly noted in the Final Office Action, established case law makes clear the requirement of a “useful, concrete and tangible result.” The Applicants respectfully submit that claims 1-63 satisfy these requirements.

Regarding the need for a tangible result, the Interim Guidelines state:

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a Sec. 101 judicial exception, in that the process claim must set forth a practical application of that Sec. 101 judicial exception to produce a real-world result. *Benson*, 409 U.S. at 71-72, 175 USPQ at 76-77 (invention ineligible because had “no substantial practical application.”). “[A]n application of a law of nature or mathematical formula to a . . . process may well be deserving of patent protection.” *Diehr*, 450 U.S. at 187, 209 USPQ at 8 (emphasis added); see also *Corning*, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 (“It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . .”). In other words, the opposite meaning of “tangible” is “abstract.”

Interim Guidelines, p. 21. The operations recited in independent Claims 1, 19, 36 and 50 satisfy this requirement in that they, among other things, provide for causing a processor to generate a customer portal view, which in turn allows a user to invoke a workflow process embodied as instructions on a computer-readable storage medium by selecting a user-selectable option. In so doing, the invocation of the workflow process causes the workflow process to invoke at least one of a plurality of business service methods,

thereby causing a function associated with the selected option to be performed.

Moreover, these operations are performed with specific structural requirements, both in terms of the physical apparatus (the processor) to which the invention is tied, and also in terms of structural requirements imposed on the software in use (the use of a user interface to allow a user to invoke a workflow process, and (in turn) a business service method, thereby causing a function associated with the selected option to be performed), a process that is significantly more structured and complex than simply allowing a user to select a function to perform. These operations do not provide an abstract result, but rather a tangible result, the invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with the selected option. The customer portal view is also inherently tangible, as is made apparent in Figure 9C.

Regarding the need for a concrete result, the Interim Guidelines state:

Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" claim should be rejected under section 101). The opposite of "concrete" is unrepeatable or unpredictable. Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field. An appropriate rejection under 35 U.S.C. Sec. 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. Sec. 112, paragraph 1, where the invention cannot operate as intended without undue experimentation. See *infra*.

Interim Guidelines, p. 22. The Final Office Action provides no rationale as to why any of Claims 1-63 do not satisfy this requirement. Claims 1-63 recite operations that clearly produce a useful result (the invocation of a workflow process, and so the performance of a function associated with the selected option), which is readily, substantially repeatable. Further, causing a processor to receive input from a user is repeatable. The practical, real-world useful result sought in the Final Office Action is therefore clear: the performance of a function associated with the selected option, via the invocation of a workflow process to allow a user to process complex orders.

Applicants, however, have amended independent Claims 1, 19, 36 and 50 to more clearly recite the relationships between the claimed elements that contribute to the aforementioned usefulness, as well as the useful, concrete, tangible results provided by the claimed invention. Thus, the amended independent claims now recite, for example, that the input received from the user comprises a selection of at least a selected option of the user-selectable options, and that at least one of the plurality of workflow processes is invoked in response to the selection of the at least the option of the plurality of user-selectable options. Claims 1, 19 and 36 recite a physical processor, and Claims 1 and 19 expressly state that the instructions on the computer-readable storage medium are configured to cause the processor to undertake specific actions. These and other amendments more clearly demonstrate the relationships between the elements in question, as well as the fact that the claimed invention does indeed provide a “useful, concrete and tangible result.”

Further, amended Claims 1, 19 and 36 recite a computer-readable storage medium, which is undoubtedly tangible. Such a computer-readable medium is supported

in the specification, by way of non-limiting example, at page 79, line 33. Similarly, amended Claim 50 recites a presenting step. Presenting is supported, by way of non-limiting example of its tangible embodiments, at Figures 9B-9E and the supporting text at pages 29 (starting at line 9)-35.

Accordingly, the Applicants respectfully submit that Claims 1-63 satisfy the requirements of 35 U.S.C § 101.

The Examiner has courteously attempted to respond to this argument at page 7 of the Final Office Action, stating:

Applicant's claimed invention results in "transforming at least a portion of the business object into a complex object." (claim 50, last limitation).

Independent system claim 1 results in implementing the method through the last system limitation of "the at least one of the plurality of workflow processes is configured to invoke at least one of the plurality of business service methods to perform a function associated with the selected option."

Independent system claim 19 results in "the transformation engine is further configured to generate the at least a portion of the complex object using the business object."

Independent apparatus 36 results in a "means for transforming at least a portion of the business object into a complex object."

These end results fail to meet the requirements of 35 U.S.C. § 101 because they are mere software instructions which fail end in the required result. A qualifying method step result must result in a useful action which may be automated through a computer system and related apparatus, computer readable medium storing the software and related apparatus, not merely a software modification.

Final Office Action, p. 7. Applicants respectfully submit that the Final Office Action's response fails to recognize the several clearly tangible steps called specifically to attention. Among other things, the independent claims provide for the generation of a customer portal view, which in turn allows a user to invoke a workflow process by selecting a user-selectable option. This step is further made tangible by the amended claim's reliance upon a specific apparatus in the recited "causing said processor to" limitations. This customer portal view is not addressed by the Final Office Action, and Applicants arguments as to the meaning of the cited sections of interim guidelines are not contested by the Final Office Action. Applicants respectfully submit that the Final Office Action has misapplied 35 U.S.C. § 101. For this reason, Applicants respectfully submit that the Final Office Action's rejection of Claims 1-63 is unfounded; Applicants respectfully request that the Examiner withdraw the Final Office Action's rejection of Claims 1-63 under 35 U.S.C § 101 and that a Notice of Allowance be issued for all pending claims.

- II. The rejection of Claims 1-63 under 35 U.S.C. § 112, first paragraph, as failing to support the claimed invention by either a clearly asserted utility or a well-established utility is unfounded and should be withdrawn.

Claims 1-63 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to support the claimed invention by either a clearly asserted utility or a well-established utility. Applicants respectfully traverse this rejection. Applicants respectfully submit that, having demonstrated the utility of the claimed invention in responding to the rejection of claims 1-63 under 35 U.S.C § 101, Applicants have also demonstrated that the Specification provides information sufficient to allow one of skill in the art to practice and use the claimed invention.

The Examiner has courteously attempted to respond to this argument at page 9 of the Final Office Action, stating:

The MPEP states claims which fail to meet the requirements of 35 U.S.C. § 101 automatically fail to meet the requirements of 35 U.S.C. § 112-1st paragraph.

Final Office Action, p. 9. Applicants respectfully submit that the Applicants' arguments with respect to 35 U.S.C. § 101 have overcome the Final Office Action's rejection with respect to both 35 U.S.C. § 101 and the present rejection under 35 U.S.C. § 112, first paragraph. Applicants respectfully submit that the Final Office Action has misapplied both 35 U.S.C. § 101 and 35 U.S.C. § 112, first paragraph. For this reason, Applicants respectfully submit that the Final Office Action's rejection of Claims 1-63 is unfounded; Applicants respectfully request that the Examiner withdraw the Final Office Action's

rejections of Claims 1-63 under 35 U.S.C § 112, first paragraph, and that a Notice of Allowance be issued for all pending claims.

- III. The rejection of Claims 1-63 under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which applicant regards as the invention is unfounded and should be withdrawn.

Claims 1-63 further stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly failing to set forth the subject matter which the applicant(s) regard as their invention. The Final Office Action posits the following:

In that paper [the Specification filed December 17, 2001], applicant has stated the invention has the purpose of processing complex orders which include complex services and products, and this statement indicates that the invention is different from what is defined in the claim(s) because the independent claims do not include a limitation which indicates the processing of orders????

Final Office Action, p. 3. Applicants respectfully disagree. Each of the independent claims includes language that clearly demonstrates that the invention claimed thereby is concerned with processing complex orders which include complex services and products. For example, Claim 1 is directed to a “complex order processing system” (which is affected by the claim limitations) and, at the very least explicitly recites display of a list of orders in a customer portal view. In Claim 19, the claimed order processing system functions by managing and transforming complex objects representing at least one of services, orders and/or quotes. With regard to Claim 36, an apparatus for processing orders is claimed, wherein business service methods are used to process orders for at least one of services, orders and/or quotes, which are represented by business objects. Finally,

Claim 50 is directed to order processing functions by managing and transforming complex objects representing at least one of services, orders and/or quotes. As will be appreciated, in contrast to statements made in the Final Office Action, the independent claims, and so the dependent claims, are indeed directed to the processing of complex orders which include complex services and products.

The Examiner has courteously attempted to respond to this argument at page 9 of the Final Office Action, stating:

In spite of further modifying the claims, though only in minor ways, the applicant has failed to claim a method, system, apparatus and computer medium which accomplish the processing of orders. The clearly stated accomplishment is stated in the final limitation of claim 50, and is supported by the final limitations in the other independent claims of systems and apparatus with a computer readable medium, namely to “transforming at least a portion of the business object into a complex object” (claim 50, last limitation). This is why the claims continue to not meet the requirements of 35 U.S.C. 112-2nd paragraph.

Final Office Action, p. 9. The Examiner has concentrated on the final limitation of each claim. Applicants are aware of no precedent requiring such a connection between the literal wording of the preamble and the final limitation. Applicants respectfully submit that each of the independent claims, and likewise the dependent claims, relates to order-processing interactions in the explicit terms of at least one limitation that result in the requisite complex order processing. For this reason, Applicants respectfully request that the Examiner withdraw the Final Office Action’s rejection of Claims 1-63 under 35 U.S.C § 112, second paragraph, and that a Notice of Allowance be issued for all pending claims.

- IV. The rejection of Claims 1-63 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is unfounded and should be withdrawn.

Claims 1-63 further stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Final Office Action posits:

For example, the limitation “at least one business service method performs a function associated with the selected option” in independent method claim 50 is vague and indefinite.” Independent Claims 1, 19 and 36 contain similar enabling limitations.

Final Office Action, p. 4. Applicants have previously amended Claim 50 and Claim 36 to further clarify the indicated limitations, now reciting “a selected option from among the plurality of user-selectable options,” which Applicants believe renders moot the rejections of Claim 50 and Claim 36. Applicants have likewise amended Claim 19 to recite “the transformation engine is further configured to generate the at least a portion of the complex object using the business object.”

In the case of Claim 1, however, Applicants most respectfully disagree. The Final Office Action points to the limitation “the at least one of the plurality of workflow processes is configured to invoke at least one of the plurality of business service methods to perform a function associated with the selected option.” Applicants have reviewed Claim 1 and find that each of the three recited limitations of Claim 1 that is preceded by a definite article is also supported by an antecedent within Claim 1. Specifically, “the

selected option,” which Applicants believe to be the basis of the Examiner’s rejection, is supported with an antecedent “a selected option” at line 12 of Claim 1. For this reason, Applicants respectfully request that the Examiner withdraw the Final Office Action’s rejection of Claims 1-63 under 35 U.S.C § 112, second paragraph, and that a Notice of Allowance be issued for all pending claims.

V. The rejection of Claims 1-63 under 35 U.S.C. § 103(a) as being unpatentable over *Esposito* in view of *Wiecha* and Official Notice is unfounded and should be withdrawn.

Claims 1-63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Esposito* in view of *Wiecha* and Official Notice. While not conceding that the cited references qualify as prior art, but instead to expedite prosecution, Applicants have chosen to respectfully disagree and traverse the rejection as follows. Applicants have reserved the right, for example, in a continuing application, to establish that the cited references, or other references cited now or hereafter, do not qualify as prior art as to an invention embodiment previously, currently, or subsequently claimed.

In order for a claim to be rendered invalid under 35 U.S.C. § 103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. *See* 35 U.S.C. § 103(a). This requires: (1) the references must teach or suggest all of the claim limitations; (2) there must be some teaching, suggestion or motivation to combine references either in the references themselves or in the knowledge of the art; and (3) there must be a reasonable expectation

of success. *See* MPEP 2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Applicants have amended independent Claims 1, 19, and 36 in the manner of claim 50, which now reads as follows:

50. A method for processing orders comprising:
 generating a customer portal, wherein
 the generating a customer portal comprises
 a list of products and services associated with an account,
 a list of quotes associated with the account,
 a list of orders associated with the account, and
 a plurality of user-selectable options, and
 presenting the customer portal such that the customer portal is
 accessible by a user, wherein
 the user is one of a customer service representative, a
 customer, and a service provider for the customer;
 invoking a workflow process, wherein
 the workflow process invokes at least one business service method,
 and
 the at least one business service method performs a function
 associated with a selected option from among the plurality
 of user-selectable options;
 receiving at least one of:
 a service profile,
 quote information, and
 order information pertaining to an account;
 generating a business object, wherein
 the generating is based on the at least one of
 the service profile,
 the quote information, and
 the order information; and
 transforming at least a portion of the business object into a complex
 object.

By contrast, *Esposito* is directed to a method and system for conducting real time electronic commerce, and describes:

... a system for providing real-time notification of purchaser requirements in a heterogeneous network environment The

heterogeneous network environment can include a public packet switched network, such as the Internet, and a wireless network, such as a plurality of pagers. Select embodiments include a plurality of wireless terminals in communication with the wireless network to receive real-time notification of a purchaser's requirements. At least one vendor computer is part of the system. The vendor computer has one or more databases for storing information about products and services in a product database, and a customer database, for storing information about customers. A plurality of client computers are part of the system. The client computers enable users to interact with the system to learn about and express interest in products and services.

See Esposito, Abstract. By further contrast, *Wiecha* is directed to a system for ordering items over computer network using an electronic catalog, and describes an approach in which:

Current corporate purchasing procedures are labor-intensive and therefore costly. The system enables an employee who needs an item which must be ordered from a supplier to select the item from an electronic catalog displayed on a personal computer and submit an order for approval and processing directly, by-passing both the normal paper approvals and the manual verification of the order by the organization's Purchasing department. It achieves this by means of an electronic catalog accessible from the employee's own personal computer, and a computer network and associated services linking the enterprise to one or more suppliers.

See Wiecha, Abstract.

As an initial matter, the Final Office Action states that, basically, the Abstract of *Esposito* teaches the claimed invention, save for construction of the software for processing complex customer inquiries and purchase orders. *See* Final Office Action, p. 5. No specific citation, *e.g.*, page and line, to *Wiecha* is made at all with regard to independent Claims 1, 19, 36 and 50. With regard to the dependent claims, no citation whatsoever is made to *Esposito* or *Wiecha*. Applicant is left to conclude that these claims

are rejected simply for depending on a rejected claim. The Final Office Action merely picks a few of the claims, states that certain of such terminology such as that used in the claims is known (a point that Applicants do not concede), and then goes on to state that such are obvious as such terminology is known to users of systems from SAP, Baan and Oracle (once again, a point that Applicants do not concede).

Applicants therefore respectfully submit that the particular parts of the cited references that are relied upon in the Final Office Action have not been designated as nearly as practicable, and the pertinence of each reference has not been clearly explained, both as required by 37 C.F.R. § 1.104(c)(2). *See also* MPEP § 706.02(j). Moreover, the Final Office Action then proceeds to summarily make a bare assertion of obviousness of almost every limitation of the independent claims. Again, no mention is made of the references that would enable Applicants to ascertain which sections of the references the Final Office Action purports to map to the limitations of Applicants' claims. Applicants respectfully request, in light of the present Request for Continuing Examination, that the Examiner, in the next office action, more thoroughly discharge the obligation that the particular parts of the cited references that are relied upon in the office action be designated as nearly as practicable, and the pertinence of each reference be clearly explained.

Further, the rejection is based upon a list of various items, some within the references and some which are not, that are loosely, if at all, connected to various elements in Applicants' claims without further support. Further still, the items recited in the references (such as they are) are generally unrelated to one another, resulting in inconsistency, and clearly have very little to do with Applicants' claims as recited.

Applicants further object to the Examiner's various assertions of "inherency" in various elements in that such inherencies are either false or otherwise insufficient to sustain the rejection. Nevertheless, Applicants have made every effort to respond to the rejections outlined in the Final Office Action.

However, the Final Office Action does correctly state that *Esposito* fails to teach the construction of the software for processing complex customer inquiries and purchase orders. See Final Office Action, p. 5. For example, nowhere in *Esposito* is there shown, taught or suggested the generation of a customer portal. Moreover, nowhere is there shown, taught or suggested the invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option. This is the case because *Esposito* teaches a "...a system for providing real-time notification of purchaser requirements in a heterogeneous network environment" See *Esposito*, Abstract. Thus, *Esposito* is directed to conducting real time electronic commerce, and is not equipped to deal with complex order processing, as in the claimed invention.

Wiecha is directed to a system for ordering items over a computer network using an electronic catalog. However, there is nothing taught by *Wiecha* that demonstrates anything more than simply a computer-based catalog system that allows a user to order items in the catalog electronically. This is just a system that enables an employee who needs an item which must be ordered from a supplier to select the item from an electronic catalog displayed on a personal computer and submit an order for approval and processing directly, by-passing both the normal paper approvals and the manual verification of the order by the organization's Purchasing department.

By marked contrast, the claimed invention is directed, for example, to the processing of complex orders by the generation of a customer portal. Moreover, nowhere in the references is there shown, taught or suggested the invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option. Thus, neither *Esposito* nor *Wiecha*, taken alone or in permissible combination, shows, teaches or suggests (or has reason to do so) the use of the claimed invocations to address a user's need to perform certain functions in providing processing of complex orders.

In addition to the foregoing infirmities, this lack of invocations results from the fact that neither *Esposito* nor *Wiecha*, taken separately or in any permissible combination, have need nor recognition of technology such as that provided by the claimed invention. That neither reference teaches such technology thus comes as no surprise. In *Esposito*, the chosen approach is preferred in order to provide real-time notification of purchaser requirements in a heterogeneous network environment, and so the use of the claimed technology goes unrecognized and unappreciated. Given that the claimed processing of complex orders is achieved through the invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option, such functionality cannot be exercised in systems employing the design of *Esposito*. *Wiecha* fails to cure this infirmity of *Esposito*.

To wit, while *Esposito* may discuss a system which enables an employee who needs an item which must be ordered from a supplier to select the item from an electronic catalog displayed on a personal computer and submit an order for approval and processing, nothing is shown, taught or suggested with regard to the invocation of a

workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option. This is at least for the reason that *Esposito* is concerned with avoiding the traditional use of paper documents and used for Purchasing department approval. Given that *Wiecha* has no need of the claimed technology in achieving this end, one of skill in the art would not look to *Wiecha*'s disclosure for such teachings. In fact, given that *Wiecha* fails to demonstrate any sort of need for such technology, one would not expect one of skill in the art to look anywhere therefore. Thus, *Wiecha* provides neither a way to modify *Esposito*, nor does either reference demonstrate any sort of a need for such technology.

Thus, the Final Office Action does not establish the presence of these limitations in *Esposito* or *Wiecha*, taken alone or in permissible combination. As the Examiner appreciates, the burden is of supporting a case of obviousness lies with the Office, including whether the prior art references teach or suggest all of the claim limitations. See MPEP 706.02(j). For the reasons presented above, neither *Esposito* nor *Wiecha*, taken alone or in permissible combination, teach these limitations of claim 50, as well as the remaining independent claims.

In addition, Applicants also respectfully submit that the Final Office Action fails to satisfy the burden of factually supporting the alleged motivation to combine the two references. The duty of factually supporting the alleged motivation to combine may not be satisfied by engaging impermissible hindsight; any conclusion of obviousness must be reached on the basis of facts gleaned from the references. Evidence must therefore be provided to suggest the combination, and, as will be appreciated, "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not

‘evidence.’” *See In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). The Final Office Action’s failure to meet this criteria is particularly evident with regard to the dependent claims, wherein neither reference is cited as teaching any recited limitation, nor is Official Notice taken thereof (which, Applicants maintain, would be inappropriate in any event).

In this regard, Applicants respectfully submit that *Esposito* and *Wiecha*, taken alone or in permissible combination, are not capable of presenting a system in which the invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option, exist. Such technology is simply not shown, taught or suggested by either of these references. For the claimed invention, the ability to process complex orders in the manner discussed in the specification and recited in the claims, the combination of the use of *Esposito* and *Wiecha* is inadequate, particularly given that such is achieved through the invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option.

This leads to the conclusion that not only do *Esposito* and *Wiecha* fail to show, teach or suggest such technology, but have no need to do so, because neither recognizes these benefits. Failing to appreciate these benefits, neither references addresses the obstacles that exist to creating solutions, nor providing any such solutions, such as those provided by the claimed invention. Lacking such appreciation and teachings, one of skill in the art could not find any motivation to combine their disclosures, because neither could be seen as lacking in this regard. Save for having the present disclosure to use as a blueprint, and so implying the use of hindsight, an obviously impermissible approach,

which need not be dealt with here, the proposed combination is without motivation and support.

Further, the Final Office Action does not establish that such a combination of the teachings of these references would meet with success, as required. This comes as no surprise, as there is no way to combine these references to achieve the claimed invention, as demonstrated by the foregoing. Moreover, there is no teaching in the references, nor any extant in the skill in the art, which would provide the teachings necessary to successfully combine the disclosures of *Esposito* and *Wiecha*. Certainly, each of *Esposito* and *Wiecha* is directed to its own solution to its own problems, and is a self-sufficient and self-contained solution in that regard.

Were one of skill in the art to proceed regardless (a fruitless effort and one which Applicants do not concede in any event), the combination would still fail to teach the claimed invention, if only in regard to the claimed invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option. At best, such a combination would yield a system for ordering items over computer network using an electronic catalog, that would provide such services using real time electronic commerce. Thus, the claimed invention, by its recognition of the need for complex order processing, is in no way made obvious (nor anticipated) by *Esposito* and/or *Wiecha*, taken alone or in any permissible combination.

The Final Office Action responds to this argument by asserting that,

“In the instant case, the examiner has followed the Supreme Court’s upholding as cited above of the guidelines offered in the circuit Court’s *In re Kahn* opinion presented assessments of what the ordinary practitioner of the art would have known and would have derived by common sense at the time of Applicant’s invention Applicant is referred

to the prior art references and rationale presented in the above rejections. The examiner has not made “mere conclusory statements”, but has instead provided “rational underpinning to support the legal conclusion of obviousness”. As stated above, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim. Instead, the examiner has taken into account “the inferences and creative steps that a person of ordinary skill in the art would employ” by combining two prior art references with the stated rationale regarding what one of ordinary skill in the art would have known and found obvious at the time of Applicant’s invention. As such, the examiner considers that the above rejections meet the standards of a properly made *prima facie* case of obviousness rejection. The MPEP establishes a bar for Applicant to overcome in traversing the examiner’s prior art references and rejection rationale. The Examiner maintains the opinion that Applicant’s arguments fail to meet the requirements of that bar for a proper reversal.

See Final Office Action, p.13. Applicants respectfully disagree.

The Examiner correctly notes that the portion of *In re Kahn* cited by the *Ex Parte Catan* states that “Rejections based on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” See Office Action, p.13. The Final Office Action’s failure to meet this criteria is particularly evident with regard to the dependent claims, wherein neither reference is cited as teaching any recited limitation, nor is Official Notice taken thereof (which, Applicants maintain, would be inappropriate in any event). Applicants respectfully submit that analysis implies the citation of evidence, supported by reasoning. The assertion that “the steps represent generically obvious steps of the well known order placement and acceptance process, mixed with special terminology...were well known to purchasing and customer service professional users... Therefore it would have been obvious...” is a naked assertion without adequate evidentiary support. Applicants respectfully submit that the Final Office Action has dismissed fifty-nine dependent claims without a single citation to any teaching of the two references on which the rejection is based and with only a passing

mention of terms found in three of the fifty-nine dependent claims. Applicants respectfully submit that the dismissal of nearly thirty pages of claim language in less than one page of text from the Final Office Action is both conclusory and inadequate.

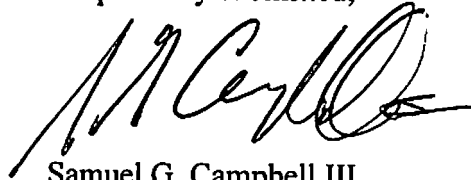
For these reasons, Applicants respectfully submit that the Final Office Action fails to present a *prima facie* case of obviousness of amended independent claims 1, 19, 36 and 50, and all claims dependent upon them, and that they are in condition for allowance. Applicants therefore respectfully submit that the Final Office Action's rejection of Claims 1-63 under 35 U.S.C. §103 is unfounded and request that the Examiner withdraw the Final Office Action's rejections. Applicants request that a Notice of Allowance be issued for all pending claims.

CONCLUSION

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. Applicant also hereby authorizes that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. § 1.16 or § 1.17, be charged to Deposit Account 502306.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'S. G. Campbell III', with a stylized flourish at the end.

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